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| APPLICATION NO.                     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|------------------------|------------------|
| 10/708,562                          | 03/11/2004  | Rakesh K. Parimi     | FIS920030422           | 2561             |
| 23550                               | 7590        | 12/05/2006           | EXAMINER               |                  |
| HOFFMAN WARNICK & D'ALESSANDRO, LLC |             |                      | MASKULINSKI, MICHAEL C |                  |
| 75 STATE STREET                     |             |                      | ART UNIT               |                  |
| 14TH FLOOR                          |             |                      | PAPER NUMBER           |                  |
| ALBANY, NY 12207                    |             |                      | 2113                   |                  |

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 10/708,562             |  | PARIMI, RAKESH K    |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Michael C. Maskulinski |  | 2113                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/11/04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**Non-Final Office Action**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-13 are not limited to tangible embodiments. In view of Applicant's disclosure, specification paragraph 0026, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., data storage system) and intangible embodiments (e.g., transmission media). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Farchi et al., US 2003/0046613 A1.

Referring to claims 1, 9, and 14:

- a. In paragraph 0012, Farchi et al. disclose testing a client program for opening a connection to a server (performing automatic testing of a system

including a plurality of modules in which at least two modules lack a predetermined communication mechanism).

b. In paragraph 0016, Farchi et al. disclose creating a test suite for testing a program (establishing at least one test goal for testing regarding at least one of a module and an interface point between modules; providing at least one test script configured to conduct a test at each module and each interface point).

c. In paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the coverage criteria that are input to an automated test generator to create the test cases, which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically revise the test cases to correct inadequacies (generating a test map for each test goal, each test map configured to run at least one test script for each module and each interface point in accordance with the test goal; and automatically testing the system using each test map).

d. With respect to claim 9, in paragraph 0023, Farchi et al. disclose a computer readable medium embodying computer-readable code.

Referring to claims 2, 10, and 15, in paragraph 0026, Farchi et al. disclose that the coverage tool generates a test coverage report based on the test trace and the coverage criteria and this report is utilized to judge the suitability of the program under test (the step of scoring a test result for at least one of the test goal and each test script).

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Referring to claims 3, 11, and 16, in paragraph 0030, Farchi et al. disclose that by inputting test traces from multiple test suites, test suites that are too restrictive and/or that are inefficient can be identified and additional criteria can be automatically created to correct those deficiencies (wherein a test script is included in a test map only if the test script has a score that is greater than a threshold score).

Referring to claims 4, 12, and 17, in paragraph 0030, Farchi et al. disclose that by inputting test traces from multiple test suites, test suites that are too restrictive and/or that are inefficient can be identified and additional criteria can be automatically created to correct those deficiencies (wherein the generating step includes generating a test map for a given test goal only if the given test goal has a score that is greater than a threshold score).

Referring to claims 5 and 18, in paragraph 0026, Farchi et al. disclose that the coverage tool generates a test coverage report based on the test trace and the coverage criteria (further comprising the step of recording a test result for each test script).

Referring to claim 6, in paragraph 0016, Farchi et al. disclose creating a test suite (further comprising the step of recording each test map).

Referring to claims 7 and 19, in paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the coverage criteria that are input to an automated test generator to create the test cases, which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically

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revise the test cases to correct inadequacies (further comprising the step of repeating the steps of generating and automatically testing after correction of a failure).

Referring to claims 8, 13, and 20, in paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the coverage criteria that are input to an automated test generator to create the test cases which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically revise the test cases to correct inadequacies (further comprising the step of modifying the test map based on a modeling rule).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art is related to different methods of regression testing and modifying test coverage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Maskulinski whose telephone number is 571-272-3649. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael C Maskulinski  
Examiner  
Art Unit 2113